

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John R. Jacobson et al.
Serial No.: 09/808,584
Filed: March 14, 2001
Title: COATING APPARATUS

Art Unit: 1734
Examiner: Edwards
Confirmation No.: 3434

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
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REPLY BRIEF

Appellants submit the following Reply Brief in response to the Examiner's Answer dated May 24, 2006.

With respect to the patentability of claim 1, the Examiner's Answer states, "[Appellant's] argument is not deemed persuasive in that Jonkers provides for an applicator or stencil roller (3) through which coating material is metered via metering bar (4) for transfer onto the web or sheet in contact with the surface of the stencil roller." Examiner's Answer, page 6, second full paragraph. (Emphasis added.) Claim 1 does not recite "an applicator through which coating material is metered." This is precisely the point of distinction Appellants have been trying to explain. Claim 1 recites, in relevant part, "a metering bar comprising a fixed arcuate end positioned against said applicator to meter a predetermined amount of coating composition to the applicator for transfer to an article transported to said applicator by said conveyor." (Emphasis added.) The coating composition of Jonkers passes through a stencil roller (3). According to Jonkers, "[T]he quantity of the dyepaste which [sic] is deposited [sic] through the stencil is constant." Jonkers, col. 3, lines 20-23. Thus, the apparatus of Jonkers does not include a metering bar positioned against an applicator to meter a predetermined amount of coating composition to the applicator for transfer to an article. Jonkers thus fails to teach each and every element of the apparatus of claim 1. Since Jaffe et al. do not cure the deficiencies of Jonkers, the proposed combination of Jonkers and Jaffe et al. cannot render obvious the apparatus of claim 1. Appellants request, therefore, that the Board

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overrule the rejection of claims 1-9, 19-24, 29-31 35 and 37 under 35 U.S.C. § 103 over Jonkers in view of Jaffa et al.

Regarding the patentability of claim 2, the Examiner's Answer states, "One of ordinary skill in the art would appreciate that the selection of an appropriate hardness of the applicator roller for the purposes of enhanced durability or resistance to wear of the applicator with a given product or article." Examiner's Answer, paragraph bridging pages 6 and 7. There is no teaching or suggestion in either Jonkers or Jaffe et al. or the combination thereof that the hardness of the Jonkers stencil is an important property to be optimized --let alone that is important to durability or resistance to wear of the Jonkers stencil (the motivation alleged in the Examiner's Answer). Therefore, the alleged motivation is not supported by the record. Moreover, nothing in either Jonkers or Jaffe et al. teaches or suggests the specific hardness of no greater than about 55 Shore A. The skilled artisan thus would have no reason to modify the stencil of Jonkers to possess any particular hardness --let alone a durometer of no greater than about 55 Shore A. The rejection of claim 2 under 35 U.S.C. § 103 over Jonkers in view of Jaffa et al. thus is unwarranted and Appellants request that it be overruled.

Regarding the Examiner's comments with respect to claim 8, which specifies that the conveyor and the applicator are configured to enable the applicator to apply a coating to the edge face of a roll of tape disposed between the conveyor and the applicator, Appellants once again emphasize that there must be some motivation in Jonkers or Jaffe et al. or the combination thereof for modifying the apparatus of Jonkers to enable coating the edge face of a roll of tape. Nothing in the record, including the Examiner's Answer, establishes the requisite motivation. In particular, nothing in the record provides a reason as to why the skilled artisan would alter the apparatus that allegedly results from the proposed combination of Jonkers and Jaffe et al. so as to enable it to coat the edge face of a roll of tape. Jonkers is directed to coating webs or strips. Jaffe et al. is directed to coating cloth panels or plastic sheets. The Examiner's Answer asserts, "[T]he capability of the routineer in the art to configure the apparatus combined by Jonkers and Jaffe et al. to apply coating material to a thicker sheet or web would be no different from the claimed invention" *Id.*, page 7, first full paragraph. The test for obviousness is not whether "the routineer in the art" would be able to configure a hypothetical apparatus. Rather, the

test is whether there is a teaching, suggestion or motivation either in the reference itself, or in the knowledge generally available to one of skill in the art, to modify the reference or to combine the teachings of references, so as to achieve the claimed invention. See MPEP 2143.01. In addition, the references must teach or suggest all of the limitations in the claim. Here there is no such teaching, suggestion or motivation. In particular, nothing in either Jonkers or Jaffa et al. teaches or suggests modifying the apparatus of Jonkers to enable it to coat the edge face of a roll of tape. As such, a *prima facie* case of obviousness of claim 8 has not been established. Accordingly, Appellants request that the rejection of claim 8 under 35 U.S.C. § 103 over Jonkers in view of Jaffa et al. be overruled.


With respect to claims 9 and 57, the Examiner's Answer asserts, "One of ordinary skill in the art would readily recognize the rotary cylindrical screen to read on an applicator roller because it is round or cylindrical, rotates, and applies coating material to the web or sheet in contact therewith." Examiner's Answer, page 7, second full paragraph. The Examiner's Answer clouds the issue. The question is not whether the stencil of Jonkers could ever be an applicator. The question is whether the stencil of Jonkers receives a predetermined amount of coating composition for transfer to an article. The answer is that it does not. The stencil of Jonkers prevents a dyepaste from being applied to a substrate in certain areas of the stencil, i.e., the land areas of the stencil, and allows dyepaste to pass through and be applied by a squeegee to a substrate in other areas of the stencil, i.e., the holes in the stencil. As a result, the stencil of Jonkers is not an applicator roller to which a predetermined amount of coating composition is metered for transfer to an article. In addition, the squeegee of Jonkers applies dyepaste to a web. The squeegee of Jonkers is not a roller. As such, the proposed combination of Jonkers and Jaffa et al. lacks a required element of claims 9 and 57. Appellants request, therefore, that the rejection of claims 9 and 57 under 35 U.S.C. § 103 over Jonkers in view of Jaffa et al. be overruled.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. In particular, Appellants respectfully request that the Board overrule the rejections of record with directions to pass the above-captioned application to allowance.

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Respectfully submitted,

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